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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,626	12/05/2003	John A. Griego	06530.0318	9106

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,626

Applicant(s)

GRIEGO ET AL.

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-33, 35-40, 42-44, 46, 47, 49-53, 55, 57 and 59-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-33, 35-40, 42-47, 49-53, 55, 66-73, 92-110 and 112 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-14, 57, 59-65, 74-91 and 111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on August 24, 2005, canceled claims 7, 34, 41, 45, 48, 54, 56, and 58; amended claims 1, 8, 11, 12, 15, 29, 30, 39, 43, 47, 49, 50, 55, 57, 65-67, 69, 72-74, 81, and 92; and claims new 111 and 112 are acknowledged. The current rejections of the claims are *withdrawn*. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 8-10, 12-14, 74-77, 81-84, 88-91 and 111 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,982,727 to Sato.

In regards to claims 1-2, 74-77, 81-84 and 111, Sato discloses a medical device for use with an endoscope, comprising: a proximal handle 4; a distal assembly 3 for performing a medical procedure, and a wire coil connecting the proximal handle to the distal assembly, the wire coil having a proximal portion comprised of a first wire 19 and a distal portion 17 comprised of a second wire, wherein the second wire has a wire diameter less than a wire diameter of the first wire, so that the distal portion of the wire coil has a flexibility greater than a flexibility of the proximal portion (see Col. 3, Lines 5-13) and wherein actuation of the proximal handle causes actuation of the distal

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assembly to perform the medical procedure and deflection of the distal portion (see Col. 3, Lines 25-48). The apparatus of Sato is considered inherently capable of performing the recited method claims.

In regards to claim 3, Sato discloses a medical device, wherein the device is configured to selectively deflect the distal portion relative to the proximal portion (see Fig. 5).

In regards to claims 8-10, Sato discloses a medical device, wherein actuation of the handle from a first position to a second position actuates the distal assembly, and actuation of the handle from the second position to a third position deflects the distal portion relative to the proximal portion (see Col. 3, Lines 25-48).

In regards to claims 12-13, Sato discloses a medical device, wherein the handle includes a first actuation member 16 for actuating the distal assembly and a second actuation member 4 for deflecting the distal portion (see Col. 3, Lines 25-48).

In regards to claims 14 and 88-91, Sato discloses a medical device, wherein the distal assembly includes a biopsy forceps assembly (see Col. 2, Lines 50-53)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,982,727 to Sato in view of U.S. Patent No. 5,741,429 to Donadio, III et al.

In regards to claims 4-6 and 78-80, Sato discloses a medical device for use with an endoscope but is silent with respect to wherein the proximal portion includes a first outer jacket, and to wherein the distal portion includes a second outer jacket, wherein the second outer jacket is made of a material different than a material of the first outer jacket. Donadio, III et al. teach of an analogous flexible tubular device for insertion into the body during medical procedures wherein varying the configuration of the multi-wire coil along the length of the flexible tubular member 20 can result in a flexible tubular member 20 with varying characteristics. For example, the variation of the composition and thickness of the coating material will also vary the flexibility of the coated flexible tubular member (20) (see Col. 8, Lines 20-24). It would have been obvious to one skilled in the art at the time the invention was made to have a second jacket made of a different material than the first jacket in the apparatus of Turturro et al. to provide a tubular section with varying flexibility characteristics as taught by Donadio, III et al. The combined apparatus of Sato and Donadio, III et al. is considered to be inherently capable of the recited method steps.

Claims 11 and 57, 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,982,727 to Sato in view of U.S. Patent No. 5,967,997 to Turturro et al.

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In regards to claims 11, 57 and 85-87, Sato discloses a medical device for use with an endoscope but is silent with respect a deflection control member wherein the deflection control member is configured to hold the distal portion in a deflected position. Turturro et al. teach of an analogous medical device having a deflecting member 17 having control over the distal portion of the wire coil (see Fig. 6 and Col. 7, Lines 27-46). It would have been obvious to one skilled in the art at the time the invention was made to include a deflection control member in the apparatus of Sato to allow the user greater control over the distal portion of the wire oil as taught by Turturro et al. The combined apparatus of Sato and Turturro et al. is considered to be inherently capable of the recited method steps.

Claims 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,982,727 to Sato in view of U.S. Patent No. 5,967,997 to Turturro et al. in further view of U.S. Patent No. 5,741,429 to Donadio, III et al.

In regards to claims 59-65, the combined apparatus of Sato, Turturro et al. and Donadio, III et al. is considered to be inherently capable of the recited method steps.

Allowable Subject Matter

Claims 15-33, 35-40, 42-47, 49-53, 55, 66-73, 92-110 and 112 are allowed.

Response to Arguments

Applicant's arguments with respect to claims 1, 57 and 74 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

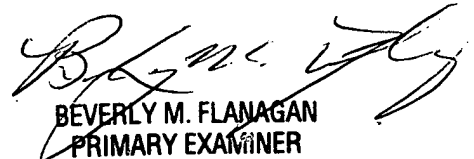
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK *mt*

10/25/05


BEVERLY M. FLANAGAN
PRIMARY EXAMINER